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EXAMINER

WALKE, AMANDA C

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER T. AYLWARD,
JAMES S. HONAN, and
NARASIMHARAO DONTULA

Appeal 2009-003107
Application 10/827,398
Technology Center 1700

Decided: March 18, 2010

Before ADRIENE LEPIANE HANLON, CHUNG K. PAK, and
TERRY J. OWENS, *Administrative Patent Judges*.

HANLON, *Administrative Patent Judge*.

DECISION ON APPEAL

A. STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134 from an Examiner's decision rejecting claims 1-25. We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM.

Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A method for placing indicia on the non-image side of a support for an imaging element comprising providing a support, wherein said imaging support comprises an image side having at least one imaging layer and a non-image side; contacting said non-image side of said support with a thermal transfer dye donating sheet; applying energy in a pattern to said thermal transfer dye donating sheet; and transferring said pattern to said non-image side of said support to form indicia, and applying an environmental protection laminate layer to said indicia on said non-image side of said support.

App. Br., Claims Appendix.¹

The only Examiner's rejection before us on appeal is the rejection of claims 1-25 under 35 U.S.C. § 103(a) as unpatentable over the combination of Campbell,² Chang,³ and Jones.⁴

B. ISSUES

The Appellants argue the patentability of claims 1-25 as a group. Thus, the sole issue on appeal is:

Have the Appellants identified harmful error in the Examiner's conclusion that the steps of using a thermal transfer printing process to form indicia on the non-image side of a support and applying an environmental protection layer to that indicia, as recited in claim 1, would have been obvious to one of ordinary skill in the art in view of the combined teachings of Campbell, Chang, and Jones?

¹ Appeal Brief dated February 14, 2008.

² US 5,612,283 to Campbell issued March 18, 1997.

³ US 6,476,842 B1 to Chang issued November 5, 2002.

⁴ US 2003/0038174 A1 to Jones published February 27, 2003.

C. FINDINGS OF FACT

Campbell discloses a dye-receiving element for thermal dye transfer comprising a support having, on the front side thereof, a biaxially-oriented composite film laminated to the support and a dye imaging-receiving layer. A biaxially-oriented transparent film is also laminated to the back side of the support. Campbell 2:1-12.

Campbell discloses that the support may be, for example, a polymeric, a synthetic paper, or a cellulose fiber paper support. Campbell 2:13-16.

Campbell discloses that in a typical extrusion lamination process, back printing labels, water marks and logos are applied directly to the back side of the paper support stock with inks applied by a gravure printing process. Campbell 2:17-20; *see also* Campbell 5:66-67 (paper stocks were back printed with a logo).

Chang discloses that thermal transfer printing may be used to produce indicia on a surface of coated or plain paper. Chang 1:44-49.

Jones discloses that a protective layer may be affixed over at least a portion of an image-receiving layer carrying indicia. Jones discloses that the protective layer protects the image-receiving layer from damage and prevents bleeding of thermal transfer dye. Jones, para. [0024].

D. PRINCIPLES OF LAW

The test for obviousness “is what the combined teachings of the references would have suggested to those of ordinary skill in the art.” The test is not that the claimed invention must be expressly suggested in any one or all of the references. *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

Facts relevant to a determination of obviousness include (1) the scope and content of the prior art, (2) any differences between the claimed

invention and the prior art, (3) the level of skill in the art, and (4) any relevant objective evidence of obviousness or non-obviousness. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

In order for a showing of “unexpected results” to be probative evidence of non-obviousness, it falls upon the Appellant to at least establish: (1) that there actually is a difference between the results obtained through the claimed invention and those of the prior art; and (2) that the difference actually obtained would not have been expected by one skilled in the art at the time of invention. *In re Freeman*, 474 F.2d 1318, 1324 (CCPA 1973).

Furthermore, “objective evidence of nonobviousness must be commensurate in scope with the claims.” *In re Lindner*, 457 F.2d 506, 508 (CCPA 1972).

E. ANALYSIS

The Examiner found that Campbell does not print indicia on the non-image side of a support using a thermal transfer printing process and does not apply a protection layer to the printed indicia. Nonetheless, the Examiner found that Chang establishes that thermal transfer printing was known to be used to print indicia on a substrate, such as coated or plain paper. The Examiner also found that Jones establishes that it was known to provide a protective layer over indicia to protect the indicia and prevent it from bleeding. Ans. 3-4.⁵

Based on these teachings in Chang and Jones, the Examiner concluded that it would have been obvious to one of ordinary skill in the art to use a thermal transfer printing process to form indicia on the non-image

⁵ Examiner’s Answer dated March 25, 2008.

side of the support in Campbell and protect the indicia with a protective layer as disclosed in Jones. Ans. 4.

According to the Appellants, Campbell teaches laminating a clear film to a back side of an imaging element when back side printing is present. Reply Br. 3-4.⁶ However, the Appellants argue that none of the references teaches or suggests “the application of an environmental protective layer *limited to* the area covered by the indicia.” App. Br. 5 (emphasis added).

The Appellants’ argument is not persuasive of reversible error. Although Claim 1 recites that the environmental protection layer is applied “to” the indicia, the claim is broad enough to include an application step whereby the environmental protection layer is applied to the indicia as well as to areas that are not covered by the indicia.

Jones discloses that a protective layer may be affixed over at least a portion of an image-receiving layer carrying indicia. Jones, para. [0024]. Thus, we find that Jones discloses “applying an environmental protection laminate layer to said indicia” as recited in claim 1.

The Appellants argue that Jones applies the environmental protection layer over an image receiving layer in contrast to the claimed method which does not employ a “special image receiving layer” on the non-image side of the support. App. Br. 5.

The Appellants’ argument fails to consider the prior art as a whole. The Examiner merely relied on Jones to establish that, at the time of the Appellants’ invention, protective layers were known to be used to protect indicia. The Examiner determined that it would have been within the skill of the ordinary artisan to use the protection layer disclosed in Jones to protect

⁶ Reply Brief dated May 21, 2008.

indicia printed on other surfaces, such as the non-image side of the support in Campbell. *See* Ans. 4. On this record, the Appellants have failed to direct us to any evidence to the contrary.

The Appellants also argue that “[t]he references, alone and in combination, provide no reasonable expectation of success of printing on the backside of an imaging element, which backside does not bear a special image receiving layer.” App. Br. 5.

We disagree. Chang discloses that a thermal transfer printing process may be used to produce indicia on a surface of coated or plain paper. Chang 1:44-49. Chang does not disclose that the coated or plain paper has a “special image receiving layer” as alleged by the Appellants. Rather, Chang discloses that the paper has a “dye receptive surface.” Chang 1:65-2:3. The Appellants have failed to direct us to any evidence establishing that the “dye receptive surface” in Chang is a “special image receiving layer.” Thus, on this record, Chang provides a reasonable expectation of success in using the disclosed thermal transfer printing process to form indicia on the non-image side of the paper support in Campbell which admittedly does not have a dye image-receiving layer.⁷ *See* App. Br. 4.

Finally, the Appellants argue that Table 1 on page 63 of the Specification illustrates a “surprising result.” App. Br. 5-6.

Table 1 reports data for three Samples, i.e., Samples 1, 2, and 3. According to the Appellants’ Specification, Sample 1 is the control, Sample 2 includes an environmental protection layer over print, and Sample 3 is the

⁷The Appellants recognize that the non-image side of the support recited in claim 1 is not limited to a particular material. *See* Reply Br. 4 (“the back side of the imaging element can be any material, for example, paper or silver halide-containing materials”).

same as Sample 2 but does not include an environmental protection layer over print. *See* Spec. 63, Table 1.

In the case of Sample 2, no loss in the dye density of the *protected* print is said to have been observed when the imaging element was exposed to either high or low pH conditions. However, in the case of Sample 3, some dye density loss of the *unprotected* print is said to have been observed when the imaging element was exposed to different pH conditions. Spec. 64.

Significantly, the Appellants have failed to explain why the results reported in Table 1 would not have been expected by one of ordinary skill in the art. *Freeman*, 474 F.2d at 1324. That is, the Appellants have failed to explain why the protected print in Sample 2 would not have been expected to maintain its dye density.

Moreover, to the extent that the environmental protection layer in the Appellants' Example was only applied to the area of the support covered by the indicia, the evidence is not commensurate in scope with claim 1. *Lindner*, 457 F.2d at 508. As discussed above, claim 1 does not limit the application of the environmental protection layer to only those areas of the support covered by the indicia. Thus, for at least these reasons, the Appellants' evidence is not probative of non-obviousness.

In sum, the Appellants have not identified harmful error in the Examiner's conclusion that the steps of using a thermal transfer printing process to form indicia on the non-image side of a support and applying an environmental protection layer to that indicia, as recited in claim 1, would have been obvious to one of ordinary skill in the art in view of the combined teachings of Campbell, Chang, and Jones.

Appeal 2009-003107
Application 10/827,398

E. DECISION

The decision of the Examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

tc

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